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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,212	07/18/2003	Rickey D. Hart	022956-0233	2862

21125 7590 01/18/2007  
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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/623,212

Applicant(s)

HART, RICKEY D.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 61-69, 71-89 and 95 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 72-75 is/are allowed.
- 6) ☒ Claim(s) 61-69, 71, 76-84 and 95 is/are rejected.
- 7) ☒ Claim(s) 85-89 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Reopened Prosecution***

As a result of the pre-appeal-brief conference held October 18, 2006, prosecution of this application was reopened. An office action on the merits follows.

***Claim Objections***

Claims 84 and 85-89 are objected to because of the following informalities:

In claim 84, lines 7-8, "the proximal end" lacks clear antecedent basis. The Examiner suggests changing it to ---a proximal end--- in order to overcome this objection.

With regard to claim 85, on line 9, "the stabilizing element" lacks clear antecedent basis since there are two such elements previously set forth. The Examiner suggests changing "the stabilizing element" to ---the second stabilizing element--- in order to overcome this objection. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-69, 71, and 75-84 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble et al (US 4,870,957) in view of Nicholson et al (US 5,725,529). Goble discloses a method of anchoring soft tissue within bone with an ACL replacement; see the abstract. The claimed step of threading soft tissue through an aperture is taught by Goble where soft tissue is slid into eyelet (18) as described on

column 6, lines 26-38. However, the step of drilling a hole in bone is not disclosed even though a hole to insert the Goble device is formed in the bone; see Figures 4 to 6 and claim 17. However, Nicholson teaches that it was known to the art to form holes in bones with drills; see column 12, line 29 et seq. Therefore, it is the Examiner's position that it would have been obvious to an ordinary artisan to utilize a K-wire and drill to form the tunnel of Goble for the same reasons that Nicholson utilizes the same and to prevent unnecessary damage to the bone if the K-wire location is later thought to be undesirable.

With regard to claim 84, a tendon graft can be obtained and utilized in the method thereof; see column 7, lines 53-64. Furthermore, the step of pulling the Goble device would have been considered obvious if not inherent to an ordinary artisan in that moving it into the knee would be most apparently done by a pulling force; see Figure 4.

With regard to claim 95, the non-cylindrical axial channel as claimed is met by the hexagonal opening of Goble; see column 6, lines 3-17. The larger diameter as claimed is met by the barbed end of the device as best shown in Figure 3, and the stepped hole as claimed is met by the threaded surface; see Figure 4.

With regard to claims 61-69, 71, and 75-83, Goble discloses an interference fit between the stabilizing device and the insertion device but not a compression fit as claimed. However, Nicholson teaches that it was known to use a compression fit in combination with interference fit with similar devices within the art; see the abstract and Figure 8. Therefore, it is the Examiner's position that it would have been obvious to

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utilize a compression fit along with the interference fit to better secure the two components together and for the same reasons that Nicholson utilizes the same.

With regard to claim 68, the use of a flange is taught by Nicholson; see the Figures. Therefore, it would have been *prima facie* obvious to use the same in the Goble device for the same reasons that Nicholson utilizes the same.

### ***Allowable Subject Matter***

Claims 84 to 89 contain objectionable language, but would be allowable if rewritten to eliminate such language as suggested by the Examiner *supra*.

Claims 72-74 are allowed over the prior art of record.

### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Prebilic", with a long horizontal flourish extending to the right.

Paul Prebilic  
Primary Examiner  
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